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|--|-------------|----------------------|---------------------|------------------|
| 10/534,228 | 05/30/2006 | Masanori Naritomi | 052528 | 3365 |
| 38834 7590 06/23/2010 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036 | | | | |
| EXAMINER | | | | |
| KRUEER, KEVIN R | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1787 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 06/23/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary

Application No.

10/534,228

Applicant(s)

NARITOMI ET AL.

Examiner

KEVIN R. KRUEER

Art Unit

1787

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/16/2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 3, 5, 6 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) 6, 8, 9, and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 5 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 6, 8, 9, and 13-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/05/2009.

Drawings

The drawings filed 5/6/2005 are accepted.

Specification

The abstract of the disclosure is objected to because it is not on a separate sheet. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 5 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are directed to a film with a surface roughness of "5um to 50um." However, applicant fails to describe how said surface roughness is measured/determined. As is known in the art, the method of measuring surface roughness can vary and will significantly affect the reported surface roughness value (see US 20090263737 (0040) and US 20090229856 (0025)). Thus, the failure to

disclose the method by which surface roughness was determined renders the claim indefinite because the skilled artisan would not know how to make the claimed invention or how to determine if a film fell within the scope of the pending claims.

Similarly, applicant claims the surface should have "fine recesses or projections of not larger than 1um" (claim 1) or "of "0.01um to 0.1um in diameter" on the surface. It is not clear how the skilled artisan would go about determining the size of recesses or projections. To determine the height, one must establish a reference point by which said height/recesses will be determined. It is not clear what said reference point is in the present application. It could possibly be the highest peak on the surface, the lowest recess, or an "average" thickness calculated by some undetermined process. Furthermore, to determine the size of projections and recesses which are irregular in shape, it must be clear at what point in the recess/projection the size is being determined: the middle, the highest possible point or lowest possible point, etc. With regards to the recorded diameter, it is not clear how applicant is determining the diameter of the irregular surface features (see Figures).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 3, 5, and 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use

the invention. It is unclear how the claimed surface roughness and "fine recesses or projections" are to be measured. The method of measurement will greatly affect the claimed range and the assessment of what prior art reads on the claimed invention.

Response to Arguments

Applicant's arguments filed 3/16/2010 have been fully considered but are not persuasive.

Applicant argues the surface roughness of the presently claimed composition means a maximum profile valley depth according to ISO 4287. Said argument is noted but is not persuasive because applicant fails to point to any implicit or explicit support in the specification for such a reading. Applicant further argues one of ordinary skill in the art would understand the "the presently claimed composition and this expression method for the surface roughness feature." Said arguments are noted but not fully understood. It is not clear what is meant by "expression feature." Furthermore, the arguments are not persuasive because counsel's argument cannot take the place of evidence.

Applicant further argues the claimed artisan would "focus more upon the feature of 'fine recesses or projections of 0.01 μ m to 0.1 μ m in diameter on the surface." Applicant argues said feature is novel and non-obvious. Said argument is noted but is not persuasive because applicant fails to address the pending 112 rejections related to the cited claim limitation. Furthermore, applicant fails to explain how "focusing more" upon said feature clarifies the indefinite surface roughness limitation. Applicant argues the diameters of the recesses are measured by taking a photograph of the surface

using a scanning electron microscope and then drawing lines around the contours of the recesses. Said argument is noted but is not persuasive because the examiner cannot find support in the original disclosure for said test method. Furthermore, it is not known how the diameter of the recess is determined using said method as the diameter does not measure outer contours of a recess. Applicant's described method seems to measure the circumference of the circle. The diameter typically measures the length of a straight line passing through the center of a circle and connecting two points on the circumference.

For the reasons given above, the rejections are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN R. KRUER whose telephone number is (571)272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin R Kruer/
Primary Examiner, Art Unit 1787